

## REMARKS

This Response is submitted in response to the final Office Action dated March 26, 2003 and the Office Action dated June 6, 2003. A Request for Continued Examination is submitted herewith. A Petition for a Two-Month Extension of Time to Submit this Response is submitted herewith. A Supplemental Declaration of Aaron Jones is also submitted herewith. New Claim 49 has been added. No new matter has been added. A check in the amount of \$1,262.00 is submitted to cover the cost of the RCE, two-month extension and new independent Claim. Please charge Deposit Account No. 02-1818 for any in sufficiency or credit for any overpayment.

The Office Action of June 26, 2003 appears to have accepted the amended title and the amendments to the claims set forth in the May 23, 2003 Response to Final Office Action. Those changes are incorporated in the Claims set forth above.

The Office Action of June 6, 2003 maintained the rejection of Claims 1-8, 11-24, 26-32, and 34-48 under 35 U.S.C. § 103(a) as being unpatentable over Heidel in view of Lemay and Fey in the March 26, 2003 Office Action. Applicant respectfully disagrees with this rejection and traverses based on the following. Applicant also submits the Supplemental Declaration of Under 37 C.F.R. § 1.132 of Aaron Jones, as discussed below.

### **I. Response to Statements in the Office Action of June 6, 2003**

Prior to addressing the pending claims and the rejection of those claims, Applicant will briefly address the statements in the June 6, 2003 Office Action.

The June 6, 2003 Office Action stated that:

Applicant argues that the prior art fails to teach context sensitive help because Heidel fails to teach context sensitive help. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant respectfully submits that Applicant was merely pointing out that the prior art references do not disclose that a selection of a specific symbol on a reel by a player will cause the gaming machine to display a payable or a part of the payable associated with that specific player selected symbol. This is accurate and explains the content of the prior art references relied upon in combination with other references which is clearly relevant for the obviousness determination.

The June 6, 2003 Office Action further stated that:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that the obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one skilled in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case hyperlinks and context sensitive help is notoriously well known to those of ordinary skill in the art. Context sensitive help appears in virtually every modern computer application. The Internet is replete with web pages with hyperlinks to places where more information about a particular topic may be had. Even Assignee's webpage has hyperlinks of this type. It is virtually inconceivable that one of ordinary skill in the art would not know about hyperlinks and context sensitive help and the benefits to be gained by their use.

It is respectfully submitted that this response misses Applicant's argument. Applicant's argument is that there is no motivation or suggestion in the references relied upon by the Office Action to combine the idea of hyperlinking with an entire payable or entire payable request input and then to change the input to be a specific player selected symbol and then to change the portion of the payable displayed (when that specific symbol is selected) to be the part of the payable specifically for that symbol. Applicant respectfully submits that even if one of ordinary skill in the art would combine hyperlinking with the payable, there is no additional specific motivation or suggestion to

further modify such combination by displaying the specific part of a payable for a symbol when that symbol is selected. Applicant respectfully submits that such additional motivation or suggestion can only be derived from improper hindsight.

It is well-settled law that obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention. *ATD Corp v. Lydall, Inc.*, 48 U.S.P.Q. 2d 1321, 1329 (Fed. Cir. 1998). The Federal Circuit has clearly iterated that:

[v]irtually all inventions are necessarily combinations of old elements. The notation, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate Prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.

*Panduit Corporation v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1575 (Fed. Cir. 1987). Moreover, the Federal Circuit has specifically cautioned against from doing exactly what the Office Action in the present application has done:

[a]s this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

....

...To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

*Yamanouchi Pharmaceutical Co., Ltd., et al v. Danbury Pharmacal, Inc., et al.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) (Rehearing and Rehearing En Banc Denied, December 14, 2000).

When the Patent Office fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers

that the obviousness determination has been impermissibly made in hindsight. *In re Rouffet*, supra, (citing *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991)). Additionally, the M.P.E.P. mandates that impermissible hindsight must be avoided and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art (See M.P.E.P. §2141.03). Although, as stated in case law often relied on by the U.S. Patent Office (See e.g., paragraph A of subsection X of § 2145 of the M.P.E.P.), that “[a]ny judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning” *In re MacLaughlin* 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (CCPA 1971), this nonetheless does not relieve the Patent Office of ensuring that the obviousness determination takes into account only knowledge which was with the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned from the applicant’s disclosure.

The June 6, 2003 Office Action also stated that:

Applicant argues that constant display of a payable would be faster than a hyperlinked version. Yet Applicant has submitted an affidavit that claims that hyperlinking to a payable meets a long felt need because modern paytables are too large to display continuously. Applicant cannot have it both ways. If modern paytables are not too long to be continuously displayed, then there is no long felt need. If, as Applicant’s affidavit asserts, modern paytables are too long to be continuously displayed, then it would be faster to hyperlink to a particular symbol in the payable than to scroll through several pages. (Incidentally, the Supplemental Declaration Under 37 CFR §1.132 of Aaron Jones has not been entered for the reasons detailed in the Final Office Action.)

It is respectfully submitted that this is not Applicant’s argument. Applicant is not asking to “have it both ways.” Applicant’s point is simply that if the payable is fixed on a physical display on the gaming machine, then the player can simply look at the physical display to see the payable or a portion of the payable without any additional steps. This is faster than any other method of displaying the payable; however, it does not solve the problem that, in many instances, as set forth in the original Declaration of

Aaron Jones, many paytables have become too large to display on a physical display of the machine itself. The present invention solves this problem so that the relevant part of the payable or the part of the payable that the player desires to see from such a large payable can be viewed in a much fast manner than scrolling through the multiple screens of paytables which existed prior to the present invention.

Additionally, since the June 26, 2003 Office Action indicated that the Supplemental Declaration Under 37 CFR §1.132 of Aaron Jones has not been entered for the reasons detailed in the Final Office Action, Applicant is hereby submitting a further Supplemental Declaration Under 37 CFR §1.132 of Aaron Jones which Applicant submits overcomes the reasons for not being previously entered. Applicant respectfully requests entering into the record and consideration of this Supplemental Declaration along with the previous Declaration in conjunction with this Response.

The June 26, 2003 Office Action further stated that:

The heart of Applicant's argument is that LeMay is non-analogous art. Applicant would have the "gaming machine art" cordoned off from all other areas of technology. Essentially, Applicant argues that only "gaming machine art" may be applied to "gaming machines".

But what are modern "gaming machines"? They are digital computers. Yes, they come in a different box than the desktop computer. They have flashing lights and a slot for accepting money or a credit card. But in essence, they are digital computers. They are a subset of the "digital computer art" – a peninsula perhaps, but certainly not an island, complete unto itself. Since "gaming machines" are a subset of digital computers, the art that applies to digital computers applies to "gaming machines". In other words, one of ordinary skill in the art would look to the "digital computer art" to solve problems in the "gaming machine art" – essentially those problems that have to do with generalized computing functions such as data display. While there might be "gaming machine functions" that are unique to the "gaming machine art", finding the best way to display data on a computer screen is not one of them.

Applicant also argues that the motivation to combine must be found in the LeMay reference, this is not the case. As

noted above, the motive to combine may be knowledge that is generally available to one of ordinary skill in the art. Examiner believes that knowledge of hyperlinks and context sensitive help was generally available to those of ordinary skill in the art at the time of the invention.

It is respectfully submitted that the non-analogous art argument is not the heart of Applicant's argument.

Rather, Applicant's point is that one of ordinary skill in the art at the time of invention would not be motivated based on these references to specifically modify a slot machine to enable a player to select a specific symbol on a reel of the slot machine to cause a display of the relevant part of a payable or the part of a payable for that specifically selected symbol. The rationale provided by the Office Actions do not explain why one of ordinary skill in the art would be specifically motivated to take a video slot machine known in the art at the time of the invention which employed a physically displayed payable (or player assistance or help screens activated by touch screen selection of a "Paytable," "See Pays," or "Help") and create a new feature wherein the player selection of a specific symbol on a reel would cause payable information for that specific selected symbol to be displayed to the player.

## **II. Further Response to Office Action of March 26, 2003.**

In the March 26, 2003 Office Action, the Examiner stated that:

As so well described in the specification and in Mr. Jones' Declaration, paytables have become more complex in response to demand for higher payoffs and the adoption of the digital computer to provide the processing power necessary to implement these complex games. It has become virtually impossible to display these paytables on a single display. And, even if the payable can be displayed on a single screen, there is so much data that the player cannot assimilate it all without considerable study. The last thing a casino wants is for the player to stand in front of the machine studying the paytables – the casino wants the player to play. There is a need to simplify the display of the paytables in order to give the player what he needs and only

what he needs. The Examiner recognizes that this need exists.

However, the Examiner explained that:

At one level, the problem to be address is how to efficiently display payable information on a gaming machine. But on another level, the problem is how to efficiently display textual data on a digital computer. Surely, one of ordinary skill in the art would be able to make such a small conceptual step – especially when confronted with the problem and its solution (context sensitive help and hyperlinks) on a daily basis.

Therefore, while the Examiner recognized that the need for the present invention existed, the Examiner believes that the invention is a small conceptual step. One major flaw with this reasoning is that the solution is not just context sensitive help and hyperlinks, but rather in part what is in the displayed information when a specific symbol is selected.

More specifically, the rejection of the claims is primarily based on the proposition that hyperlinking is old and one of ordinary skill in the art would apply the concept of hyperlinking to the specific symbols on the reels. Assuming, arguendo, this is accurate and it would be obvious to a person of ordinary skill in the art to apply hyperlinking to specific symbols on the reels, this rejection still has a fundamental flaw. The prior art does not teach or suggest the other elements of the claims which include exactly what the gaming device will display when a specific symbol is selected. Without gleaning anything from the present invention, there are countless things that can be displayed in a document hyperlinked to a symbol. For instance, the selected symbol could be shown in a larger format to enable the player to get a better look at the symbol. If the symbol is a representation of a person or character, information about the person or character could be displayed in the hyperlinked document. Therefore, the concept of adding hyperlinking to symbols displayed on reels does not teach or suggest the invention as a whole as set forth in the claims.

In the March 26, 2003 Office Action, the Examiner also stated that the Declaration of Aaron Jones refers:

only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

17. It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. While there is evidence that Sigma has developed a SMART TOUCH system that has the same function, it appears that this was suggested to them by someone who knew about the present invention. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Applicant submits that the accompanying Supplemental Declaration of Aaron Jones overcomes these objections and presents sufficient objective evidence of an unsolved and long-felt need for the presently claimed invention. More specifically, the Supplemental Declaration specifically references the claimed invention and specifically states the long felt need for the claimed invention. The Supplemental Declaration also explains examples of how gaming device manufacturer's were working on the problem of simplifying the display of complicated paytables and provides evidence that persons skilled in the art who were working on the problem knew of the teachings of the above cited references and were still be unable to solve the problem solved by the present invention. For instance, the first example of the addition of the "previous" button to the payable screens demonstrates that gaming device manufacturers knew that the paytables were complicated and tried to solve this problem by enabling the player to scroll backwards in addition to scrolling forward through the multiple pay screens. Moreover, as the Examiner has repeatedly stated, the "Internet surrounds as" and hyperlinking has been widely known for years. Thus, this and the other examples are clear evidence that persons skilled in the art who were presumably working on the problem of simplifying the display of payable and winning symbol information to player



and knew of the teachings of the prior art and still did not solve the problem solved by the present invention.

In regard to Sigma, if Sigma developed its SMART TOUCH independent of knowledge of the present invention, this demonstrates that others in the industry were working on the problem solved by the present invention. Alternatively, if the Sigma SMART TOUCH system was suggested to Sigma by someone who knew about the present invention, then this is evidence of copying by others which is another secondary consideration. Either way, this demonstrates that Sigma recognized the problem which is solved by the present invention and was working on the problem.

Moreover, the Supplemental Declaration Under 37 C.F.R. § 1.132 of Aaron Jones concurrently filed herewith includes three articles which independently support these conclusions. The articles are independent statements which provide objective evidence that support the statements made in the declarations of Aaron Jones that there was a long-felt but unmet need in the wagering game industry for the claimed invention. Such objective and independent statements overwhelmingly rebut the position that the presently claimed invention is a "small conceptual step."

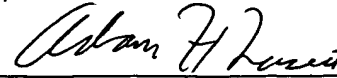
Accordingly, it is respectfully submitted that the rejection of Claims 1, 11, 34, 39, 42, 44 and 46 and the dependent claims which respectfully depend therefrom should be withdrawn.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, applicant respectfully requests that the Examiner contact the applicant's attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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BY



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